

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

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UNITED STATES PATENT AND TRADEMARK OFFICE

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTOPHER G. M. KEN and ABHIJIT ACHARYA

Appeal No. 2001-0485
Application No. 08/736,896

ON BRIEF

Before COHEN, STAAB, and NASE, Administrative Patent Judges.
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1, 3 and 4, all the claims currently pending in the application.

Appellants' invention "relates to a helical vasoocclusion coil one end of which is adapted to be detachably connected to a wire and in which the helix winding at that end has a smaller diameter than the adjacent windings" (specification, page 1). According to the specification (paragraph spanning pages 1 and 2), configuring the end to have a smaller diameter than adjacent windings serves to

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prevent injury to the wall of the vessel within which the coil is placed. A further understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to appellants' main brief.

The references applied in the final rejection are:

Mariant et al. (Mariant)	5,639,277	Jun. 17, 1997
Heinke et al. (Heinke) ¹	3,203,410	Nov. 25, 1982
(German Patent)		

Claims 1, 3 and 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Heinke in view of Mariant.

The examiner contends that Heinke discloses a helical vasoocclusion coil substantially as claimed except for the proximal end being adapted to detachably couple to a wire. The examiner cites Mariant for its teaching of a surgical device for forming a vasoocclusion that includes an end for detachably coupling to a wire, and concludes that it would have been obvious to one of ordinary skill in the art to so adapt the proximal end of Heinke's coil.

Appellants take issue with the examiner's foundation position that Heinke discloses a helical coil substantially as claimed. Specifically, appellants argue that Heinke does not disclose or

¹Translation attached.

suggest a vasoocclusion coil that is wound in the manner called for in the last paragraph of independent claims 1 and 4.

Because we agree with appellants that Heinke does not disclose or suggest a coil wound in accordance with the configuration set forth in the last paragraph of claims 1 and 4, we will not sustain the examiner's rejection. Our reasons follow.

Independent claim 1 calls for a vasoocclusion coil comprising a multiplicity of windings "having a first diameter immediately adjacent [the] distal end and [the] proximal end" of the coil,² with said coil

being further wound into a second diameter smaller than said first diameter at said proximal end and at said distal end, whereby said proximal end and said distal end are positioned radially inwardly of said immediately adjacent first diameter, such that the coil acts to occlude a vessel or a cavity when placed within said vessel or cavity.

Thus, claim 1 sets forth two requirements for the ends of the coil, namely, that the ends are "wound into a second smaller diameter than said first diameter," and that the ends "are positioned radially inwardly of said immediately adjacent first diameter." Independent claim 4 contains similar language.

²Consistent with appellants' disclosure and argument, we interpret the coil locations "immediately adjacent" the distal and proximal ends of the coil to be the coil turns next adjacent the coil ends.

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The examiner has pointed to the Figure 8 coil of Heinke and determined that modified ends 2 thereof "spiral radially inwardly" (answer, page 3) and "spiral or get radially SMALLER" (answer, page 4). In addition, the examiner has noted the statement at page 4, lines 19-21, of the Heinke translation where it is stated that the individual coil windings "telescope into one another" According to the examiner, this statement "clearly shows that the ends are positioned radially inwardly as cited in claim 1." (answer, page 4). The examiner also notes that the modified ends 2 of Heinke's coil are for the purpose of aiding in sealing off the vessel within which the coil is placed. According to the examiner, "[t]his clearly shows that the ends are radially inward to increase the sealing effect" (answer, page 4).

The Court of Appeals for the Federal Circuit clearly stated that it is erroneous to consider references in less than their entireties, i.e., to disregard disclosures in references that diverge from and teach away from the invention at hand. *W. L. Gore and Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 USPQ 303, 311 (Fed. Cir. 1983). In the present case, while we appreciate that the statements found at page 4, lines 19-21, of the Heinke translation could perhaps be interpreted as meaning that the ends 2 of Heinke's coil are configured in the manner called for in

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the last paragraph of claims 1 and 4, this circumstance must be balanced against the showing in Figure 8 of Heinke which appears to illustrate these same end portions as lying outside the coil diameter of the next adjacent coil. Our conclusion, based on our analysis of the Heinke document as a whole, is that it is simply not possible to determine with certainty the geometry of the ends of Heinke's coil. In addition, we have searched the disclosures of Heinke and the additionally applied Mariant reference in vain for a disclosure or teaching that would have suggested to one of ordinary skill in the art modifying Heinke's coil to correspond to that called for in claims 1 and 4. Finding no such disclosure or teaching, we must agree with appellants that the examiner has not met the PTO's initial burden of establishing a *prima facie* case of obviousness of the subject matter of the appealed claims.

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The decision of the examiner finally rejecting claims 1, 3 and 4 is therefore reversed.

REVERSED

IRWIN CHARLES COHEN
Administrative Patent Judge

Lawrence J. Staab
LAWRENCE J. STAAB
Administrative Patent Judge

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JEFFREY V. NASE
Administrative Patent Judge

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